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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/581,804 | 06/16/2000 | KEON-HOON YOO | A33291PCTU | 4337 |
| 21003 | 7590 | 03/22/2004 | EXAMINER | |
| BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | LEE, RIP A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1713 | |

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|--------------------------------------|-----------------------------------|--|
| Advisory Action | Application No. 09/581,804 | Applicant(s) YOO ET AL. | |
| | Examiner Rip A. Lee | Art Unit 1713 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED February 23, 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 2 and 5-7.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: see attachment to advisory action

Attachment to Advisory Action

This advisory action follows a response filed on February 23, 2004. Applicants have submitted proposed amendments for claims 1 and 8. Notably, the claims recite a lower limit of 80 % for the gel content of the large aperture latex and a total refraction coefficient of the composition between 1.510 and 1.526.

The recitation “greater than 80 and not exceeding 95 %” constitutes new matter because there is no support for the limitation anywhere in the original specification. The claims would be subject to rejection under 35 U.S.C. 112, first paragraph (see MPEP § 2163.06).

Applicants’ traversal of claims 1, 2, and 5-7 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,767,833 to Yumoto *et al.* in view of JP 56-41216 has been noted. Their arguments have been addressed previously. It is further noted that Applicant’s refractive index calculations are in error because the weight ratio does not add up to 100 %. Applicants’ statement that the combination of art does not teach each and every element of the claimed invention is also incorrect. The combination of reference does teach the chemical constituents of the claimed composition, as well as the relative amounts. The reference is simply silent with respect to physical properties. Since chemical compositions and the associated physical properties are not mutually exclusive, compositions which are essentially the same are expected to exhibit essentially the same properties. In this respect, the burden of proof was shifted to Applicants to establish unobvious differences in the claimed physical properties, but to date, this duty has not been fulfilled.


In view of the discussion above, the rejection of record has not been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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March 16, 2004



DAVID W. WU
SUPERVISORY PATENT EXAMINER
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